

REMARKS

The Advisory Action of January 19, 2006, has been considered by the Applicants. Claim 1 has been amended. Claims 1, 2, 4-8, and 10-33 remain pending in the Application. Reconsideration of the Application is requested.

In the prior response of 19 Dec 2005, Applicants stated that none of the cited references teach or suggest aging the fill material of the capsule. This process step results in a product which is different and non-obvious over the prior art capsules cited by the Examiner.

In the Advisory Action, the Examiner maintained the 103(a) rejections. These 103(a) rejections were based on Scheibl or Dugger in view of Borkan or Ebert. As one basis, she noted that Applicants' specification defined the term "room temperature" as from about 1 to 30 °C and stated it would have been obvious to one of ordinary skill that the fill material is aged while waiting to be filled into the gelatin capsule. In this respect, the Examiner's reasoning may be incorrect because it applies Applicants' definition of "room temperature" to the references when the references do not give this definition. Nonetheless, Applicants have amended claim 1 (and all of its dependent claims) to recite that the chocolate base is aged at a temperature of 30 to 40 °C. Support for this amendment can be found in the specification on page 6, lines 16-21; and page 20, lines 28-31. Fill materials were also aged at 35°C as described from page 37, line 20, to page 38, line 15. Thus, the fill material is aged at a temperature elevated above room temperature. In Example 12 on page 38, soft capsules whose filling has undergone an aging process are directly compared to capsules whose filling has not undergone an aging process and are found to have superior qualities. Applicants are unable to find in the cited references a teaching or suggestion to age the fill material above room temperature. Applicants are also unable to find a suggestion to submit the fill material to an aging process at this temperature range. Ebert discloses the capsule is dried, not the fill material. Again, the step of aging the fill material is distinct from the step of drying the capsule. This is shown in the instant specification, which describes both steps separately. Thus, it would not be obvious from Ebert to age the fill material.

The Examiner also noted that the cited references teach the properties desired by the applicant. Borkan, Ebert, and Mehta were cited as teaching capsules having superior taste. However, the fact that these references teach capsules with superior taste does not mean they achieve their superior taste in the same way as the instant application. As the Examiner noted in the Final Office Action, the patentability of product-by-process claims is determined by the product, not the process. As discussed in the prior response, Applicants have explicitly taught that the process of aging the fill material results in a structural difference in the product. See page 20, lines 10-28; page 37, line 6, to page 38, line 24; and Figs. 2-4 of the specification. None of the cited references have the process step which leads to this structural difference and the Examiner has not shown where any of the references discloses that it has the structural difference. Therefore, the product of the instant claims is neither the same as nor obvious over the prior art products.

Regarding the rejection of claims 8 and 31-33, Applicants also argued that Oohashi provided no motivation to combine. In response, the Examiner cited *In re Keller* for the proposition that the test for obviousness is what the combined teachings of the references would have suggested to those of ordinary skill in the art. The Examiner cites directly from MPEP § 2145(III); however, Applicants do not argue that Oohashi is not physically combinable with the other references. Rather, Applicants argue that Oohashi does not teach what the Examiner says he teaches. In the Final Office Action, the Examiner stated that Oohashi teaches a pharmaceutical composition for oral mucosal administration containing additives including cacao butter, coconut oil, lard, and macrogol. Oohashi does not teach that these additives are suitable for oral mucosal administration; he teaches that these additives are useful for suppository administration; see col. 3, lines 31-46. At any rate, these claims also depend from claim 1. If they depend from a non-obvious claim, they are also non-obvious. MPEP § 2143.03; *In re Fine*.

To summarize, none of the cited references (Scheibl, Dugger, Borkan, Ebert, or Oohashi) teach or suggest aging the fill material at an elevated temperature. Because aging the fill material at an elevated temperature results in a structural difference, the product is different from the prior art products. In light of amended claim 1, the claims are novel and non-obvious.

CONCLUSION

For the reasons given above, it is respectfully submitted all pending claims (1, 2, 4-8, and 10-33) are now in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.


In the event the Examiner considers personal contact advantageous to the disposition of this case, she is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

Respectfully submitted,

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March 13, 2006

Date



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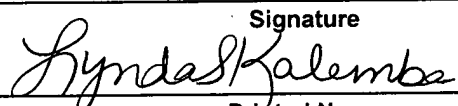
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